

REMARKS

In view of the amendments proposed above, Applicants respectfully request consideration of the following remarks.

Obviousness Rejection Under 35 U.S.C. § 103

To reject a claim or claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a prima facie case of obviousness. M.P.E.P. § 2142. When establishing a prima facie case of obviousness, the Examiner must set forth evidence showing that the following three criteria are satisfied:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. M.P.E.P. § 2142 (citing *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). Also, the evidentiary showing of a motivation or suggestion to combine prior art references "must be clear and particular." *In re Dembicza*k, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Obviousness Rejection Based on United States Patent 5,745,113 to Jordan et al. in View

of Adobe PageMill and Further in View of Simpson, Mastering WordPerfect

Claims 14, 16-25, 28, 30-35, 38, and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent 5,745,113 to Jordan et al. (hereinafter “Jordan”) in view of *Adobe PageMill User Guide, version 2.0* (hereinafter “Adobe”), and further in view of Simpson, *Mastering WordPerfect 5.1 & 5.2 for Windows* (hereinafter “Simpson”). Applicants respectfully traverse this rejection as set forth below.

Independent claim 14, as amended, recites:

14. A system for creating web documents, comprising:
 - an output display device, the output display device displaying:
 - a first list of objects, the first list of objects including a predefined HTML object *for inclusion in a web page*;
 - a second list of objects displayed simultaneous with the first list of objects, the second list of objects including a user defined HTML object *for inclusion in a web page*;
 - a view window for displaying a web page comprising one object from one of the first and second lists of objects; and
 - an input device, the input device selecting the one object from one of the first and second lists of objects for display in the page.

Each of independent claims 20 and 31 include some limitations similar to those recited in claim 1 above.

Jordan discloses a system for recording and displaying information about work practices. Column 1, Lines 44-46. The system includes a map editor, and this map editor includes a number of predefined objects (e.g., representing objects found in a typical office setting) which appear in palettes. Column 6, Lines 40-43. An object may be selected and added to a map in a drawing pane. Column 6, Lines 30-33. The map editor

is illustrated in FIG. 2, which shows an object palette 30 including a single list of predefined objects, and only a limited number of objects may be selected by the user to appear in the map editor. Column 6, Lines 43-45. Using an object editor, a user can create user defined objects by selecting an object and editing how that object is displayed in a map. Column 7, Lines 19-26.

The Examiner expressly states that Jordan fails to disclose a first list of objects including a predefined HTML object that is simultaneously displayed with a second list of object including a user defined HTML object. To overcome the lack of teaching in Jordan, the Examiner has relied upon Simpson. However, it is respectfully asserted that the Simpson reference is inapt to the present claimed invention.

The present claimed invention is directed to a system for creating a web document, wherein a first list of objects and a second list of objects are simultaneously displayed on a display device. The first list of objects includes a predefined HTML object and the second list of objects includes a user defined HTML object. The objects contained in the first and second lists are building blocks that can be used to create a web page (see, e.g., Specification, at page 24, line 2 through page 27, line 8). Thus, the claimed predefined and user defined HTML objects are objects that can be added to a web page that is being created. Each of claims 14, 20, and 31 has been amended to clarify that the claimed predefined and user defined HTML objects are objects that can be included in a web page.

Regarding Simpson, the Examiner states (Office Action, at pg. 4) that:

Simpson teaches a well known document editor called WordPerfect 5.1. In the prior art Simpson teaches that the user can create the user-defined command

objects called “Macros” (see pages 993-994). Simpson then teaches the Macros can be added to the palette as a button object (see page 998, “Attaching a macro to a button” section). In the section, Simpson teaches that the user-defined macro objects are added to the menu area after the first list which contains the pre-defined command objects that come with WordPerfect 5.1. (see FIGURE L9.3, on page 1003, “Trpose” object).

However, the elements taught in Simpson that have been identified by the Examiner (e.g., the Macros and WordPerfect’s predefined commands) are commands that perform some operation on a WordPerfect document. Such elements are not objects (HTML or otherwise) that can be added to or included in a web document. Although Simpson teaches that these commands may be displayed to the user as buttons (see pg. 1003, Figure L8.3), these buttons (e.g., “Save”, “Print”, etc.) are not objects that can be placed in or otherwise added to the document being created. Even assuming one could view the “Trpose” button in Figure L8.3 of Simpson as an object that can be included in a document – and Applicants do not believe this to be an accurate interpretation of the Simpson reference – this user created button is not displayed simultaneously along with predefined objects that can be placed in the document (i.e., the buttons for “Open”, “Paste”, “Font”, and the like are clearly not objects that can be included in a document, but rather are commands to perform certain operations). Thus, in summary, Simpson does not disclose the simultaneous display of predefined and user defined objects that can be included in a web document (or other document) that is being created.

Furthermore, it is respectfully asserted that there is no motivation to combine the disclosure of Simpson with that of Jordan and/or with that of Adobe. The Federal Circuit Court of Appeals has stated that the evidentiary showing of a motivation or suggestion to

combine prior art references “must be **clear and particular.**” *In re Dembicza*k, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999) (emphasis added).

As described above, Jordan discloses a map editor that can be used to record and display information about work practices. In contrast, Simpson discloses certain features of a word processor. Firstly, there is nothing recited in Jordan that would suggest the disclosed map editor would benefit from the common word processor features described in Simpson. Secondly, the Examiner stated motivation for combining these references is that “it would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified Jordan to display both the predefined objects and user-defined objects . . . simultaneously, since a person of ordinary skill would have appreciated the benefit of accessing the different types of command objects while authoring the document without leaving the current editor screen.” Office Action, at pages 4-5. However, as noted above, Simpson does not disclose the simultaneous display of predefined and user-defined objects for inclusion in a web page but, rather, teaches the display of a user created command (a Macro) along with a number of predefined commands (e.g., “Open”, “Save”, etc.).

As the Federal Circuit has warned:

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. *In re Dembicza*k, 50 U.S.P.Q.2d at 1617.

Thus, it is respectfully asserted that the Examiner has engaged in hindsight reconstruction based upon Applicants' disclosure and, further, that the Examiner has failed to set forth "clear and particular" evidence showing a motivation to combine Jordan, Simpson, and Adobe.

Accordingly, because the Jordan, Simpson, and Adobe references, either individually or in combination, fail to disclose at least the above-noted limitations of independent claims 14, 20, and 31 – and, further, because there is no motivation to combine these references – a *prima facie* case of obviousness can not be made out with respect to claims 14, 20, and 31. Thus, claims 14, 20, and 31 are nonobvious in view of the Jordan, Simpson, and/or Adobe.

Also, if an independent claim is nonobvious, then any claim depending from the independent claim is also nonobvious. M.P.E.P. §2143.03 (citing *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)). Therefore, claims 16-19, 38, and 39 are allowable as depending from nonobvious independent claim 14, claims 21-25, 28, and 30 are allowable as depending from nonobvious independent claim 20, and claims 32-35 are allowable as depending from nonobvious independent claim 31.

CONCLUSION

Applicants submit that claims 14, 16-25, 28, 30-35, 38, and 39 are in condition for allowance and respectfully request allowance of such claims.

Please charge any shortages and credit any overages to our Deposit Account No. 02-2666.

Respectfully submitted,

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